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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/070,157	07/12/2002	Takashi Saito	NAII 118755	9352

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EXAMINER

SCHNIZER, RICHARD A

ART UNIT	PAPER NUMBER
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1635

DATE MAILED: 03/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/070,157

Applicant(s)

SAITO, TAKASHI

Examiner

Richard Schnizer, Ph. D

Art Unit

1635

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 July 2002.
- 2a) ☐ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) _____ is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 32-97 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

A preliminary amendment was received and entered on 7/12/02. Claims 1-31 were canceled and claims 32-97 were added as requested.

Election/Restrictions

Restriction is required under 35 U.S.C. 121 and 372. Note that claims 85-97 are indefinite because they are apparatus claims that depend from method claims that do not recite an apparatus. For the purpose of restriction, these claims have been interpreted as if they depended from apparatus claims

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group 1, claim(s) 34-36, 40, 41, 46-48, 52, 53, 58-60, 64-66, 71, 72, 76, 77, 81, and 82, drawn to methods of perforating a membrane comprising bringing a photosensitizer or photocatalyst into contact with, or into close proximity to, at least a site of said membrane, providing light to denature the membrane, and perforating the membrane with a membrane destroying member that carries the photosensitizer or photocatalyst.

Groups 2-10, claim(s) 34, 46, and 58, drawn to methods of perforating a membrane comprising bringing a membrane denaturing substance into contact with, or into close proximity to, at least a site of said membrane, providing a stimulus to denature the membrane, and perforating the membrane with a membrane destroying member that carries the stimulus, wherein the stimulus is one of radiation, heat, cooling, electricity, magnetism, ultrasonic waves, chemical substances, cells, or viruses. Note that groups 2-10 correspond to radiation, heat, cooling, electricity, magnetism, ultrasonic waves, chemical substances, cells, and viruses, wherein group 2 corresponds to radiation, group 3 to heat, and group 4 to cooling, etc., such that group 10 corresponds to viruses.

Group 11, claims 85-89, 91, 92, and 96 drawn to an apparatus for perforating a membrane comprising a membrane destroying member for supporting a membrane denaturing substance that is a photosensitizer or photocatalyst that induces a membrane denaturing reaction after delivery of light, and a light supply source.

Art Unit: 1635

Groups 12-20, claim 85 drawn to an apparatus for perforating a membrane comprising a membrane destroying member for supporting a membrane denaturing substance that induces a membrane denaturing reaction after delivery of a stimulus, and a stimulus supply source, wherein the stimulus is one of radiation, heat, cooling, electricity, magnetism, ultrasonic waves, chemical substances, cells, or viruses. Note that groups 12-20 correspond to radiation, heat, cooling, electricity, magnetism, ultrasonic waves, chemical substances, cells, and viruses, wherein group 12 corresponds to radiation, group 13 to heat, and group 14 to cooling, etc., such that group 20 corresponds to viruses.

Claims 32, 33, 37-39, 42-45, 49-51, 54-57, 61-63, 67-70, 73-75, 78-80, and 83 link(s) inventions 1-10. Claims 84, 90, 93-95, and 97 link inventions 11-20. The restriction requirement among the linked inventions is subject to the nonallowance of the linking claim(s). Upon the allowance of the linking claim(s), the restriction requirement as to the linked inventions shall be withdrawn and any claim(s) depending from or otherwise including all the limitations of the allowable linking claim(s) will be entitled to examination in the instant application. Applicant(s) are advised that if any such claim(s) depending from or including all the limitations of the allowable linking claim(s) is/are presented in a continuation or divisional application, the claims of the continuation or divisional application may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. In re Ziegler, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

Claims 34, 46, and 58 are generic to a plurality of patentably distinct inventions listed as inventions 1-10. These claims will be examined only to the extent that they are defined by the elected group. Similarly claim 85 is generic to a plurality of patentably distinct inventions listed as inventions 11-20, and will be examined only to the extent that it is defined by the elected group.

The inventions listed as Groups 1-20 do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: the technical feature linking the claimed inventions is anticipated by the prior art and so is not a special technical feature under PCT Rule 13.2. For example, Berg et al (US Patent 5,876,989, issued 3/2/1999) taught a method in which a membranes were perforated by a method comprising contacting the membrane with a membrane denaturing substance that is a photosensitizer, and inducing membrane denaturation and perforation by application of light to the cells. The light source supplying the light is considered to be a membrane destroying member that carries the light stimulus. See entire document.

37 CFR 1.475(b) does not allow for combining method and apparatus claims when there is no special technical feature linking the two classes of invention. Therefore

Art Unit: 1635

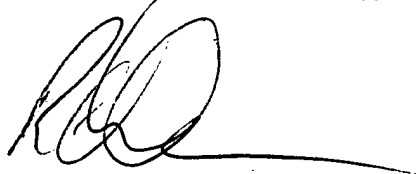
apparatus claims 84-97 are restricted from the method claims. With regard to Markush claims 34, 46, 58, and 85, the recited Markush groups lack unity of invention because the members have no common property, have no common structural feature, and do not all belong to a recognized class of chemical compounds. Furthermore, claims 34 and 58 are anticipated by Berg et al (US Patent 5,876,989, issued 3/2/1999), and so those Markush groups cannot have a special technical feature.

Any inquiry concerning this communication or earlier communications from the examiner(s) should be directed to Richard Schnizer, whose telephone number is 571-272-0762. The examiner can normally be reached Monday through Friday between the hours of 6:00 AM and 3:30. The examiner is off on alternate Fridays, but is sometimes in the office anyway.

If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Wang, can be reached at (571) 272-0811. The official central fax number is 703-872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to (571) 272-0547.

Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public.

For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.

A handwritten signature in black ink, appearing to read 'RS', with a long horizontal line extending to the right.

Richard Schnizer, Ph.D.